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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,416	01/06/2005	Serge Creutz	SN131 PCT 1	8963
137	7590	07/12/2006	EXAMINER	
DOW CORNING CORPORATION CO1232 2200 W. SALZBURG ROAD P.O. BOX 994 MIDLAND, MI 48686-0994			BOYER, CHARLES I	
			ART UNIT	PAPER NUMBER
			1751	

DATE MAILED: 07/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/521,416

Applicant(s)

CREUTZ ET AL.

Examiner

Charles I. Boyer

Art Unit

1751

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/6/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 7, and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 is confusing because based on claim 7, it appears that components A and B may be identical, that is, carboxylate esters. Accordingly, it is impossible to tell which portion of an ester component may serve as component A and which part will serve as component B. Claim 7 is confusing because it requires component B to be an ester, however, claim 6, from which claim 7 depends, requires component B to contain "unesterified -OH groups". In claim 12, it is not clear which component, A or B has the amide or amino groups. This claim should be rewritten for clarity.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 5-7, 11, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Cella et al, US 4,272,544.

Art Unit: 1751

Cella et al teach a skin lotion comprising 3% polyphenylmethylsiloxane, 2% glyceryl monostearate, 2% sorbitan monostearate, 1% ethylene glycol monostearate, 1.7% polyoxyethylene (30) stearate, which is an ethoxylated alcohol, and the balance water (col. 8, lines 30-48). As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

5. Claims 1-3, 5, 7, 11, 13, and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamada et al, US 4,719,034.

Yamada et al teach a solid silicone defoaming agent comprising 30% of a silicone composition consisting of finely divided silica and a dimethylsiloxane-methyltetradecylsiloxane-methyl(2-phenylethyl)siloxane copolymer, 30% glyceryl monostearate, and 20% propylene glycol monostearate (col. 6, example 3). As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

6. Claims 1, 5-7, 11, 13, 14, 17, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by O'Laughlin et al, US 4,868,169.

O'Laughlin et al teach a skin cream comprising up to 2% polydimethylsiloxane or polyphenylmethylsiloxane, up to 13% glyceryl monostearate, up to 7% polysorbate 60, which is an ethoxylated alcohol, micronized powder, and a wax thickener (col. 4, lines 35-53). Note that paraffin wax is a suitable thickener of the invention (col. 3, lines 15-23). As this reference meets all material limitations of the claims at hand, the reference

Art Unit: 1751

is anticipatory.

7. Claims 13 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Schmid et al, US 6,610,752.

Schmid et al teach defoamer granules comprising polydimethylsiloxane, microfine silanized silica, paraffin, and bis-stearyl ethylenediamide (col. 28, example 6). As this reference meets all material limitations of the claims at hand, the reference is anticipatory. The examiner notes that the silicone fluid of claim 13 is satisfied by polydimethylsiloxane, an extremely common defoamer in the art.

8. Claims 1, 5-7, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Minami et al, WO 01/39733 (US 6,890,543 for English translation).

Minami et al teach a lipstick comprising 2% glyceryl diisostearate, 10% silicone resin, 1% ethoxy/propoxy alcohol, and 2% methylphenylpolysiloxane (col. 10, example 21). As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 4-14, and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmid et al, US 6,610,752.

Schmid et al are relied upon as set forth above. Suitable organopolysioxanes of the invention may have as their substituents, methyl, ethyl, propyl, butyl, and phenyl (col. 2, lines 34-43). Besides silicones, other defoamers for use in the invention include the mono, di, or triesters of glycerol (col. 4, lines 64-67). Note that these granules are added to detergents which may contain well known nonionic surfactants such as ethoxylated alcohols and ethoxylated alkyl phenols (col. 9, lines 40-67). Schmid et al do not specifically teach a combination of silicone defoamers and mixtures of glycerol esters, however, as these esters are specifically taught as well known defoamers, it would have been obvious to one of ordinary skill in the art to formulate a defoaming granule incorporating these esters with a reasonable expectation of enhancing its defoaming efficacy.

11. Claims 1-3, 5-7, 9-11, 13-15, and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickinson, GB 1,523,957.

Dickinson teaches a foam control substance comprising a stearyl alcohol ethoxylate, silica, and a polydiorganosiloxane with mixed organic groups, wherein the organic groups are methyl, ethyl, and phenyl propyl, and the foam control substance is adhered to granular sodium tripolyphosphate (page 3, example 1). Suitable organic groups of the invention include octyl, tetradecyl, and phenyl (page 1, lines 41-44) and suitable additives of the invention include silicone resin copolymers, microcrystalline

Art Unit: 1751

wax, and the esters of fatty acids with polyhydric alcohols, such as glycerol monostearate (page 2, lines 15-26). Dickinson does not specifically teach a combination of the polydiorganosiloxane fluid and polyol esterified carboxylate presently claimed, however, as these esters are taught as preferred emulsifiers of the invention, it would have been obvious to one of ordinary skill in the art to incorporate an ester into example 1 and so satisfy the material limitations of the claims at hand.

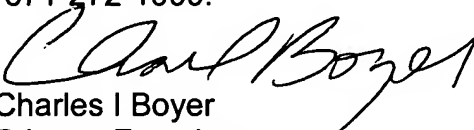
12. Claims 1-3, 5-7, 9-11, 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over L'Hostis et al, EP 1,075,863.

L'Hostis et al teach a silicone foam control substance comprising an organic fluid, a siloxane resin containing MQ groups, a silica filler having a particle size of from 0.5 to 30 microns, a particulate carrier, and a mixture of polydiorganosiloxanes, wherein at least one of the organic groups is a phenylpropyl group (page 10, claims 1-4, 10, 15, and 24). Suitable nonionic surfactants of the invention include ethoxylated alcohols and esters of glycerol (page 6, lines 30-35). L'Hostis et al do not specifically teach a combination of the polydiorganosiloxane fluid and polyol esterified carboxylate presently claimed, however, as these esters are taught as suitable nonionic surfactants of the invention, it would have been obvious to one of ordinary skill in the art to incorporate an ester into claim 1 and so satisfy the material limitations of the claims at hand.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles I. Boyer whose telephone number is 571 272 1311. The examiner can normally be reached on M-Th 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on 571 272 1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Charles I Boyer
Primary Examiner
Art Unit 1751